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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/965,851

10/01/2001

Yoshiaki Kinoshita

Q66200

4036

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08/10/2005

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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EXAMINER

BRINICH, STEPHEN M

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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09-965851

EXAMINER

ART UNIT	PAPER
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20050805

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary	Application No. 09/965,851	Applicant(s) KINOSHITA, YOSHIAKI	
	Examiner Stephen M. Brinich	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 7-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 7-8 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.

Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.

Claims 7-8, while defining a computer program, does not define a "computer-readable medium" and is thus non-statutory for that reasons. A computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the

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claim to embody the program on "computer-readable medium" in order to make the claim statutory.

In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 11-18; claim 7, lines 13-20; and claim 8, lines 14-21, image data is converted in one of two modes. The second mode is described as dependent upon the result of the result obtained by the detection section, and the first mode is described as independent of the existence of by the detection section. However, the result of the detection section determines

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which mode shall generate the final image data output (stated explicitly in the case of the second mode, and thus implied in the case of the first mode, insofar as one output or the other must result from the described operation). Thus, the first mode is dependent on the existence of the detection section, at least insofar as the detection section selects the first mode rather than the second mode.

In claim 2, lines 2-4, the second mode is used when the detecting section detects the non-existence of a point or area meeting the threshold values described in parent claim 1. This appears to contradict the recitation of parent claim 1, lines 14-16, which indicates that the second mode (rather than the first mode) is applicable when the existence of such a point or area is detected by the detecting means.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

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States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 & 5-8, insofar as they are understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Sievert (US 6012792).

Re claim 1, Sievert discloses (Figure 4B, items 302 & 304; column 9, lines 22-46) an image data processing apparatus in which color image data (specifically, the colors cyan, yellow, magenta, as indicated at column 4, line 43) and black image data are each compared to a respective threshold value by a detector (i.e. the color image value is compared to the "COLOR THRESHOLD"; the black image value is compared to a "BLACK WITH COLOR THRESHOLD"). The image processing procedure then enters one of two modes. If either of these thresholds is not exceeded, the path beginning with item 320 of Figure 4B is used to process the image data; if both of these thresholds are exceeded, the path beginning with item 306 of Figure 4B is used to process the image data.

Re claim 5, the detection occurs as recited in the special case where the "COLOR THRESHOLD" and the "BLACK WITH COLOR THRESHOLD" are equal to zero.

Re claim 6, the detection occurs as recited in the special case where the "COLOR THRESHOLD" and the "BLACK WITH COLOR

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THRESHOLD" are equal to zero and the image data values are equal to 0 or 1.

Re claims 7-8, Sievert further discloses (Figure 2 "MEMORY UNIT") a stored computer program for causing a computer ("CONTROLLER" 88) to implement the described processing operations.

Allowable Subject Matter

7. Claims 2-4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Re claim 2, the art of record does not teach or suggest two modes, one of which is selected when the existence of a certain type of point or area is detected and which operates in a certain manner in response to the detected non-existence of such a type of point or area.

Re claim 3 (and dependent claim 4), the art of record does not teach or suggest the recited detection of position in conjunction with the recited set of threshold detections for color image data and black image data.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maeda et al (column 15, lines 11-17 & column 16, line 53 - column 18, line 9) and Torpey et al (Abstract) disclose other examples of threshold testing of color and black image data.

10. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.


The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

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Hand-carried correspondence may be delivered to the
Customer Service Window, located at the Randolph Building, 401
Dulany Street, Alexandria, VA 22314.


Stephen M Brinich
Examiner
Art Unit 2624

smb
August 5, 2005